

Remarks/Arguments

The foregoing amendments to the claims are of a formal nature, and do not add new matter. Claims 119-126, 129-131 and 135-145 are pending in this application and are rejected on various grounds. Claims 119-123, 125-128 and 132-134 have been canceled without prejudice or disclaimer to claim their subject matter in subsequent continuation or divisional applications. Accordingly, Claims 124, 129-131, 135-145 are now pending in this application. The rejections to the presently pending claims are respectfully traversed.

Continuity

The Examiner asserts that Applicants have not complied with conditions to receive the benefit of an earlier filing date under 35 U.S.C. 119(e) because allegedly, the provisional application 60/141,037, filed June 23, 1999 does not impart utility to the instant invention. Applicants respectfully traverse.

Applicants have amended the instant claims to remove references to polypeptides and now refer to nucleic acids alone. Accordingly, Applicants believe they are entitled to an effective filing date of at least **June 23, 1999** for the instantly claimed subject matter. The Examiner is therefore respectfully requested to reconsider this application's priority based on this amendment.

Claim Rejections – 35 USC § 101 and §112, first paragraph

Claims 119-126, 129-131 and 135-145 are rejected under 35 U.S.C. §101 since allegedly "none of the asserted utilities are specific to the claimed nucleic acids, since such can be applied to any nucleic acid."

Claims 119-126, 129-131 and 135-145 are further rejected under 35 U.S.C. §112, first paragraph allegedly "since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility, one skilled in the art would not know how to use the claimed invention". For the reasons outlined below, Applicants respectfully disagree.

Applicants have canceled claims 119-123, 125 and 126, and further, have amended the instantly pending claims to remove references to polypeptides. Claims 139-145 do not refer to polypeptides, hence this rejection is improper for these claims. Further, a 2-fold increase in DNA copy number is considered significant (see Goddard declaration), based on the disclosure in the instant specification, one skilled in the art would know that the instant claims have utility in the detection of squamous lung carcinomas.

Accordingly, the present 35 U.S.C. §101 and §112, first paragraph utility rejections should be withdrawn.

Claim Rejections - 35 USC § 112, first paragraph- Written Description

Claims 119-123 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time of filing, had possession of the claimed invention. Applicants respectfully traverse this rejection to the pending claims.

In view of the cancellation of claims 119-123 without prejudice or disclaimer, this rejection is moot and should be withdrawn.

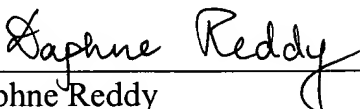
The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-2730P1C64).

Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: December 20, 2004



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